

IV. Remarks.

The Examiner entered the following rejections.

1. Claims 1, 4, 6, 13, 16, 28, 31 and 43-45 are rejected under 35 USC 102(b) as being anticipated by Winninger et al (US 6,033,331) in view of Conrad (3,980,174).

As the Examiner may recall, during the interview in SPE Cuomo's office, concerning the independent claims, we discussed the Applicant's position that none of the references teach "a rib with an angle of approximately 90 degrees". For the purposes of this rejection the Examiner has replaced the White reference with the Conrad citation. Applicant respectfully argues that Conrad does not provide that which the multiple prior references lack. Conrad simply teaches a longitudinal notch in an otherwise rectangular rib.

A rejection based on 35 USC §103(a) must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. Thus, in the context of the analysis under Section 103, *arguendo*, it is not sufficient to merely identify one reference (Winninger) that teaches some of the limitations of a claim combined with others (Conrad) that teaches other limitations of a claim to support a rejection based on obviousness. This is because obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching, suggestion or "apparent reason" that the combination be made. Interconnect Planning Corp. v. Fiel, 227 USPQ 543, 551 (Fed. Cir. 1985); In re Corkhill, 226 USPQ 1005, 1009-110 (Fed. Cir. 1985); and In re Kahn, 441 F.3d 977 (C.A.Fed.2006). The relevant analysis invokes a cornerstone principle of patent law:

That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is ... simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. Environment Designs v. Union Oil Co. of Cal., 218 USPQ 865, 870 (Fed. Cir. 1983) (Other citations omitted)

As the Court of Appeals for the Federal Circuit has noted, "[w]hen a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references." Ecologchem, Inc. v. Southern Calif. Edison, 56 USPQ 2d 1065, 1073 (Fed. Cir. 2000). This is because "combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability." Id.

Accordingly, to establish a rejection under 35 USC §103, a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but also some motivation to combine the prior art teachings *in the particular manner claimed*. (emphasis added) See e.g. In re Kotzab, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). Further, as discussed in *KSR*, citing In re Kahn

with approval, the Examiner must show reasons why the skilled artisan, confronted with the same problems as the inventors and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. See also In re Rouffet *infra*.

As to the depiction of the angles in the Winner and now the Conrad figures, as noted in previous arguments, Applicant again respectfully asserts that the reference drawings cannot be scaled when the specification otherwise expressly describes the angle depicted as is the case for Winner. The Federal Circuit has rejected scaling drawings, instead relying on written information in the specification to explain dimensional features.

“Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value”. Application of Wright, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977). “Under our precedent ... it is well established that patent drawings do not define the precise proportions of elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” Hockerson-Halberstadt, Inc. v Avia Group Intern., Inc., 222 F.3d 951, 956 (CA Fed. 2000).

The specification for Winner specifically describes the rib angles. This means the drawings cannot be scaled to separately derive information beyond the written description. The law holds that the written specification overrides the visual depiction in the figures. As we discussed during the interview, the Winner specification specifically describes the rib angle in terms of ISO 9981. The rib angle in ISO 9981 is described as 40 degrees. I believe there was agreement on this point during the interview. Continuing reliance on the reference figures to provide the claimed angle is clearly contrary to settled law.

Conrad only expressly discloses an “angle 48 [of] approximately 45°”, 3:25-26. It does not teach the angle as set forth in the claims.

This brings us to another cornerstone principle of patent law, namely, that “claims are given their broadest reasonable interpretation *consistent with the specification*.” (emphasis added) In re Hyatt, 211 F.3d 1367 (C.A.Fed. 2000).

Applicant respectfully asserts that the Examiner’s reading of the claims in light of Conrad’s teachings is overbroad and is inconsistent with the specification. The instant rib angle is disclosed as “ α ” in the application specification and is described at page 5, lines 1-5 and in Figure 1. Referring to Figure 1 in the application, the angle “ α ” relates to the relationship between the rib sides which sides diverge toward the belt tensile cords 15. Put another way, the claimed rib angle α sweeps across and encompasses rib material 25, simply, the claimed rib may be generally described as triangular in shape.

On the other hand, angle 48 in Conrad sweeps across and encompasses only void space in rib 40. Angle 48 describes the angle between a surface 44 and a line 39, 3:14-18. Hence, angle 48 and apex 45 only relate to a "concavity" of the bottom of rectangular rib 40, 3:15. In effect, angle 48 of Conrad describes a longitudinal notch in an overall rectangular rib 40, 3:24, see Fig. 4.

The ribs claimed in the present invention do not comprise a "concavity" or notch, nor do they comprise an angle with respect to a concavity or notch in a rib. Further, in Conrad sides 42 of rib 40 are parallel and so cannot describe a rib angle. Hence, in light of the Conrad notched rib the interpretation of the claims is overly broad and is not consistent with the triangular rib as described in the specification.

Nor does the Examiner describe how one skilled the art would be motivated to combine the notch 48 of Conrad with Winninger to arrive at a rib having an angle of 90°. Conrad teaches a longitudinal notch in a rectangular rib. No motivation is given for making a notch in the Winninger rib, or how that would give the invention in the particular manner claimed. Applicant asserts there is no motivation to combine since notching a Winninger rib would diminish the ability of the rib to transmit power through frictional contact with a pulley. Frictional contact with a pulley puts the rib in shear. Removing material defeats that purpose by reducing rib shear strength.

Given these defects, the Examiner does not explain how the 90° notch is transformed into a triangular 90° rib. At best Conrad teaches a portion of a rib having an angle of 45°, which is near the range taught by Winninger, see ISO 9981 per previous arguments, and which is significantly less than the range taught by the now supplanted White (60°).

"When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious. The "motivation-suggestion-teaching" requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront... and thereby resist the temptation to read into the prior art the teachings of the invention in issue. *In re Kahn, infra*.

Hence, the combination does not teach the limitation and invention arranged as in the claim. Hindsight cannot provide that which the references do not teach.

The remaining claims are dependent.

2. Claims 2 and 5, 14, 17 and 29 are rejected under 35 USC 103(a) as being unpatentable over Winninger et al and Conrad as applied to Claims 1, 13, 16 and 28, and in further view of Adifon et al (WO 99/43598).

Each of the noted claims are dependent.

3. Claims 3, 7, 15, 18-19, 21-22 and 30 are rejected under 35 USC 103(a) as being unpatentable over Winninger et al, Conrad and Adifon et al, as applied to claims 2, 14 and 29, and in further view of Suhling (DE 3,934,654) and Siefert (US 3,662,596).

Each of the noted claims are dependent.

4. Claims 7 and 19 are rejected under 35 USC 103(a) as being unpatentable over Winninger et al, White et al, Adifon et al, Suhling and Seifert as applied to claims 3 and 15, and in further view of White, Jr. et al (US3,981,462).

The noted claims are dependent.

5. Claims 8-10 and 20 are rejected under 35 USC 103(a) as being unpatentable over Winninger et al, Conrad, Adifon et al, Suhling and Seifert, and White as applied to claims 7 and 19, and in further view of Stork.

Each of the noted claims are dependent.

6. Claims 11 and 23 are rejected under 35 USC 103(a) as being unpatentable over of Winninger et al and Conrad as applied to claims 1 and 13, respectively and in further view of Siefert.

Each of the noted claims are dependent.

7. Claims 12 and 24 are rejected under 35 USC 103(a) as being unpatentable over Winninger et al and Conrad as applied to claims 1 and 13, respectively, and in further view of Suhling.

Each of the noted claims are dependent.

8. Claims 25, 33-34 and 36-37 are rejected under 35 USC 103(a) as being unpatentable over Winninger et al and Conrad as applied to claims 1 and 13 and 33 respectively, and in further view of Stork.

Each of the noted claims are dependent.

9. Claim 26 is rejected under 35 USC 103(a) as being unpatentable over Winninger et al and Conrad and Suhling and in further view of Seifert.

Please see the arguments for rejection 1 regarding the absence of "a rib with an angle of approximately 90°". Neither Suhling nor Seifert provides the missing limitation.

10. Claims 35 and 38 are rejected under 35 USC 103(a) as being unpatentable over Winninger et al, Conrad, Suhling and Seifert, as applied to claim 26, and in further view of Stork.

Each of the noted claims are dependent.

V. Fees

Any fees payable for this response including any petition fee may be deducted from deposit account 07-0475 in the name of The Gates Corporation.

Thank you for your attention to this case.

Sincerely,



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